

proximal end and the change of axis, the needle guard being engageable with the change in axis such that the distal [end] adjacent of the needle guard is stopped at the change in axis, the needle guard having a needle trap for covering the sharpened distal end of the needle substantially coincident with when the needle guard engages the change in axis. In this respect, the Examiner took the position that "the change in profile defined by a change in axis is defined by at least one outwardly bulging side wall (Figures 10A and 10B) or a recessed change in profile (Figures 7A and 7B)." For the Examiner's reference, Figures 7A and 10A of such reference are reproduced herebelow:

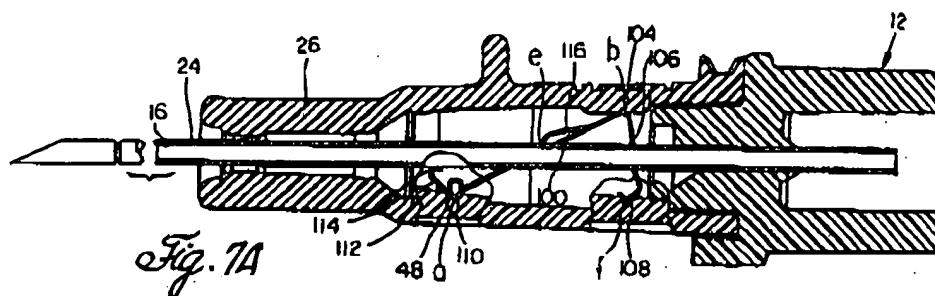


Fig. 7A

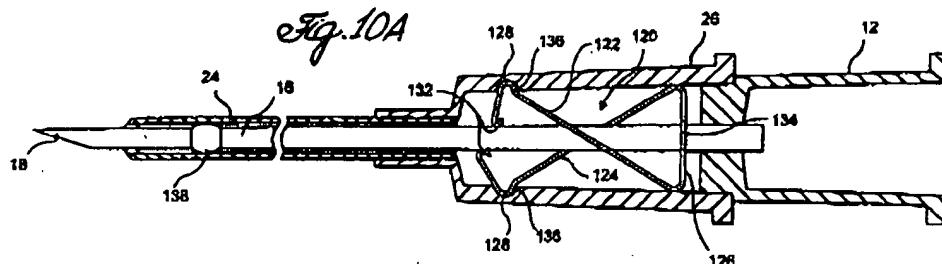
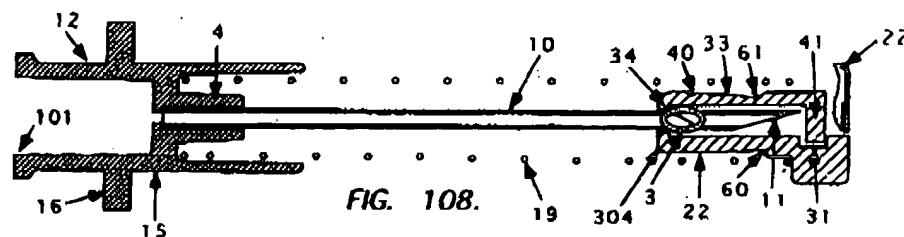
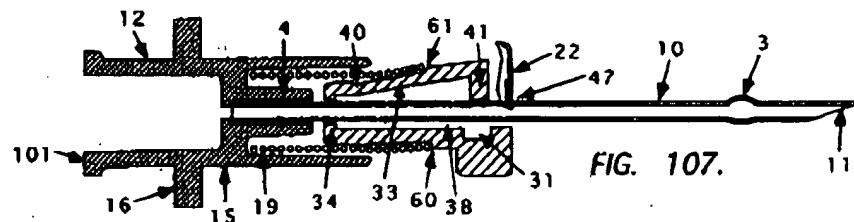
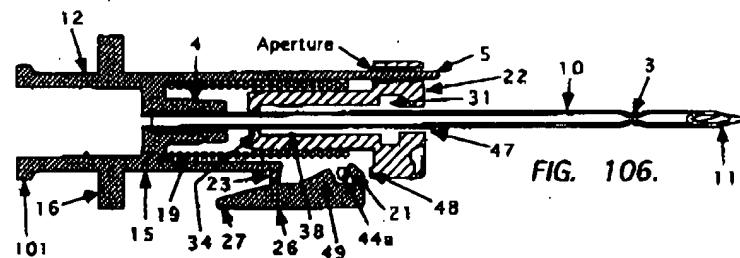


Fig. 10A

In view of the Examiner's reliance of Woehr et al. to reject the claim under 35 U.S.C. § 102(e), the Examiner is advised that the present application claims priority to and incorporates the teachings of United States Provisional Patent Application Serial Number 60/031,399 entitled HYPODERMIC DEVICES WITH IMPROVED SAFETY FEATURES, filed November 19, 1996

and United States Patent Application Serial Number 08/807,328 entitled NEEDLE TIP GUARD FOR HYPODERMIC NEEDLES, filed on February 27, 1997, now issued to Applicants as United States Patent Number 5,879,337. Such patent applications, which appear to pre-date the earliest claim to priority of the Woehr et al. reference filed June 12, 1998 as a continuation-in-part of Application Serial Number 08/915,148 filed August 20, 1997, disclose the same structural elements relied upon the Examiner in maintaining his rejection. To illustrate this point, Figures 106, 107 and 108 of the present application, which are identical to Figures 106, 107 and 108 of Application Serial Number 08/807,328, are reproduced herebelow:



Such embodiments are discussed in the present application at page 51, paragraph 0273 to page 54, paragraph 0278, which is identical to the text appearing in United States Patent Application Serial Number 08/807,328, and appears at Column 35, line 35 to Column 37, line 18 of United States Patent Number 5,879,337. Such disclosure readily references a needle protective device comprising an elongate having proximal and distal ends and a change of axis formed intermediate the proximal and distal ends; a needle guard mounted on the needle and slideable along a portion of the needle between the proximal end and the change of axis with the needle guard being engageable with the change in axis such that the distal end of the needle guard is stopped at the change of axis. The needle guard is further provided with a needle trap for covering the sharpened distal end of the needle substantially coincident with when the needle guard engages the change in axis. With respect to the change in axis, please note the recessed change in profile depicted in Figure 106, and the outwardly bulging side wall depicted in Figures 107 and 108.

As such, based upon Applicant's earlier claim to priority to and incorporation by reference of at least United States Patent Application Serial Number 08/807,328, and that such application pre-dates the earliest claim to priority of Woehr, et al., Woehr, et al. cannot be relied upon as prior art for purposes of rejecting the claims of the present application. Ecolochem, Inc. v. Southern California Edison Co., 227 F.3d 1361, 1367, 15 U.S.P.Q. 2d 1065, 1072 (Fed. Cir. 2000), *cert. denied*, 121 F. Ct. 1607 (2001) ("[T]he date of the invention is presumed to be the filing date of the parent application..."); Credle v. Bond, 25 F.3d 1566, 1570 n.13, 30 U.S.P.Q.2d 1911, 1914 n.13 (Fed. Cir. 1994) ("If [the junior party] is able to acquire the benefit

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of [the] filing [of an earlier application]...[its] effective date would then pre-date that of [the senior party]...").

In light of the foregoing clarification, Applicants respectfully submit that the basis for maintaining the rejection of the claims under 35 U.S.C. § 102(e) has been overcome and that the claims are in condition for immediate allowance. Early notice to that effect is respectfully requested. To the extent the Examiner has any questions, requires additional information, or has any suggestions to resolve any outstanding issues that may exist, he is invited to contact Applicants' counsel at the number listed below.

Respectfully submitted,

Date: 2/6/03

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